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Petition
R324
M 3.0-1307 (20-22)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 4,282,233

New York, New York

Inventor: Frank J. Villani

April 28, 1989

Issued: August 4, 1981

Assignee: Schering Corporation

For: ANTIHISTAMINIC 11-(4-PIPERIDYLDENE)

5H-BENZO-[5,6]-CYCLOHEPTA-[1,2-B]-

PYRIDINES

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324

Hon. Commissioner of Patents and Trademarks

Washington, DC 20231

PETITION UNDER 37 C.F.R. §1.324
TO CORRECT INVENTORSHIP

Sir:

It is respectfully petitioned that the above identified patent (hereinafter '233 patent) be amended to add Charles V. Magatti as a joint inventor. The originally submitted papers, through error and without any deceptive intention, failed to include said Charles V. Magatti as a co-inventor, for reasons which will be apparent from the attached declarations and the discussion herein.

In support of this Petition we submit the following:

(1) Declaration of fact submitted by the originally named inventor, Frank J. Villani.

(2) Declaration of fact submitted by the newly named inventor, Charles V. Magatti.

(3) The consent of the assignee of the '233 patent, Schering Corporation, Kenilworth, New Jersey 07033.

(4) A check in the amount of \$140.00 to cover the fee required by 37 C.F.R. §1.20(b).

The contribution of Charles V. Magatti is recited in claim 9 of the '233 patent which reads as follows:

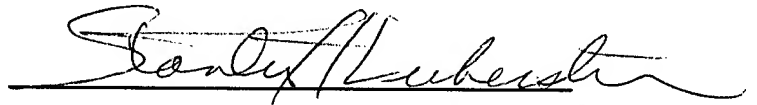
Claim 9

"11-(N-carboethoxy-4-piperidylidene)-6,11-dihydro-5H-benzo-[5-6]-cyclohepta-[1,2-b]-pyridine"

The compound of this claim will be hereinafter referred to as "SCH 25548". At first there appeared to be no interest in SCH 25548 and it was believed that the compound had been made before. However, it was later discovered that the compound was in fact new. It appears from the records that it was Mr. Magatti who: (1) first synthesized SCH 25548; (2) first appreciated SCH 25548 as a new chemical entity; and (3) provided the method for producing the compound while attempts to make similar materials had been unsuccessful. This constitutes an inventive contribution to SCH 25548 by Mr. Magatti. This compound is explicitly claimed in the '233 patent in claim 9.

For the foregoing reasons, it is submitted that this
Petition be entered and that the name of Charles V. Magatti be
added as a co-inventor of the above-identified U. S. patent.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Stanley H. Lieberstein", is written over a horizontal line.

Stanley H. Lieberstein
Registration No. 22,400
OSTROLENK, FABER, GERB & SOFFEN
1180 Avenue of the Americas
New York, NY 10036
(212) 382-0700



M 3.0-1307 (20-22)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 4,282,233

New York, New York

Inventor: Frank J. Villani

April __, 1989

Issued: August 4, 1981

Assignee: Schering Corporation

For: ANTIHISTAMINIC 11-(4-PIPERIDYLIDENE)

5H-BENZO-[5,6]-CYCLOHEPTA-[1,2-B]-

PYRIDINES

Hon. Commissioner of Patents and Trademarks

Washington, DC 20231

DECLARATION

Sir:

I, Frank J. Villani, declare as follows:

1. I am currently retired from employment with Schering Corporation in Kenilworth, New Jersey 07033.

2. At the time of filing of the patent application which resulted in the above-identified patent, i.e. in June of 1980, I was employed as a chemist by Schering Corporation. At that time there were three chemists working in the laboratory. I was the project leader, and supervised Messrs. Dhuru Vashi and Charles V. Magatti.

3. At my request, Mr. Magatti conducted dehydration decarboxylation tests of a hydroxy-carboethoxy compound under acidic conditions in an effort to obtain a desired product. Although the desired product was not obtained, Mr. Magatti did obtain a minute quantity of what is now designated SCH 25548. At first I was not interested in SCH 25548 and I was under the impression that I had made this compound earlier at Schering. Upon further review, I discovered that I had not made the compound previously, as I had initially thought.

4. Based upon a more recent review, I now believe that it was Mr. Magatti who first appreciated SCH 25548 as a new entity and it was he who achieved its first synthesis. I have been advised by counsel that these acts performed by Mr. Magatti amount to an inventive contribution to SCH 25548. Since this compound is recited in claim 9 of the above mentioned patent, I believe that Mr. Magatti's name should be included as a co-inventor.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this declaration.

Date: April 20 1989

By Frank J. Villani
Frank J. Villani

MAY
3
1989

M 3.0-1307 (20-22)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 4,282,233

New York, New York

Inventor: Frank J. Villani

April , 1989

Issued: August 4, 1981

Assignee: Schering Corporation

For: ANTIHISTAMINIC 11-(4-PIPERIDYLIDENE)

5H-BENZO-[5,6]-CYCLOHEPTA-[1,2-B]-

PYRIDINES

Hon. Commissioner of Patents and Trademarks

Washington, DC 20231

DECLARATION

Sir:

I, CHARLES V. MAGATTI, declare as follows:

1. I am employed by Schering Corporation

Kenilworth, New Jersey 07033.

2. At the time of filing of the patent application which resulted in the above-identified patent, i.e. in June of 1980, I was employed as a chemist by Schering Corporation. At that time there were only three chemists working in the laboratory, Dr. Villani the project leader, Mr. Dhiru Vashi and

myself. I recall that I was testing a dehydration decarboxylation of a hydroxy-carboethoxy compound under a variety of acidic conditions in order to obtain a certain product. The desired product was not obtained. I did, however, obtain a minute quantity of what is designated SCH 25548. I recall that my supervisor, Dr. Villani, at first indicated that there was no interest in SCH 25548 and that he believed that he had made the compound before at Schering. It was thereafter learned that this compound had not been prepared prior to my synthesis.

3. Recent discussions at Schering regarding a review of the project as a whole, including discussions with Dr. Villani and a review of my notebooks confirmed that I was the first to synthesize SCH 25548. I am advised by counsel that my acts amount to an inventive contribution to SCH 25548.

4. This compound is explicitly claimed in the above identified patent in claim 9. It is believed that the above facts require that my name be added to the patent as a co-inventor.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this declaration.

Date: 4/26/89

By Charles V. Magatti

Charles V. Magatti

21 MAY 1989
\$ 970
M 3.0-1307 (20-22)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

160.794
In re Patent No. 4,282,233

New York, New York

Inventor: Frank J. Villani

April 28, 1989

Issued: August 4, 1981

Assignee: Schering Corporation

For: ANTIHISTAMINIC 11-(4-PIPERIDYLIDENE)

5H-BENZO-[5,6]-CYCLOHEPTA-[1,2-B]-

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COMMUNICATION

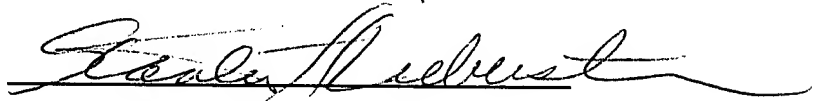
Sir:

Submitted herewith are:

1. Petition under 37 C.F.R. §1.324 to correct inventorship.
2. Consent of Assignee to add Inventor.
3. Declaration of Frank J. Villani
4. Declaration of Charles V. Magatti
5. Check No. 3801 in the amount of \$120.00 to cover the fee pursuant to 37 C.F.R. §1.20(b).
6. Power of attorney to follow.

In the event that the actual fee is greater than the payment submitted or is inadvertently not enclosed, the Patent and Trademark Office is authorized to charge the underpayment to Deposit Account #15-0700. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Stanley H. Lieberstein", written over a horizontal line.

Stanley H. Lieberstein
Registration No. 22,400
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(212) 382-0700



#7

M 3.0-1307 (20-22)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 4,282,233

Inventor: Frank J. Villani

Issued: August 4, 1981

Assignee: Schering Corporation

For: ANTIHISTAMINIC 11-(4-PIPERIDYLIDENE)

5H-BENZO-[5,6]-CYCLOHEPTA-[1,2-B]-
PYRIDINES

New York, New York

April __, 1989

Hon. Commissioner of Patents and Trademarks

Washington, DC 20231

CONSENT OF ASSIGNEE TO ADD INVENTOR
PURSUANT TO 37 C.F.R. §1.324

Sir:

Schering Corporation of Kenilworth, New Jersey 07033,
is the assignee of United States Patent No. 4,282,233 issued
August 4, 1981 which originally named one inventor, Frank J.
Villani.

Schering Corporation hereby consents to the addition of
Charles V. Magatti as a named co-inventor in said patent.

SCHERING CORPORATION

By David J. Mugford
Assistant SecretaryDate: April 20, 1989



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In re Patent No. 4,282,233

New York, New York

Inventor: Frank J. Villani

April 28, 1989

Issued: August 4, 1981

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